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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MOTOSHI ASANO and MAKOTO YAMADA

Appeal 2011-000325
Application 09/774,682
Technology Center 3600

Before BIBHU R. MOHANTY, MEREDITH C. PETRAVICK, and MICHAEL W. KIM, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1, 3-4, and 9-38 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to an electronic money system using portable information devices (Spec. 1). Claim 1, reproduced below with the numbering in brackets added, is representative of the subject matter on appeal.

> 1. An electronic-money settlement method comprising the steps of:
>
> [1] determining if an identification code for a portable electronic device is listed on a negative list, a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device as an enabled device; [2] recording, in said enabled device and a management center, information on a deposited amount of money, said information being stored in said enabled device in the form of electronic money representing a monetary value; and
>
> [3] recording, in said enabled device and said management center, information on a loan made to the user of said enabled device up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said enabled device,

[4] wherein said management center calculates interest on the loan at a predetermined frequency, and uses the calculation result to update said information on the loan.

DISPOSITION OF THE APPEAL

The Examiner entered a new ground of rejection in the Examiner's Answer against claims 17, 19, and 21-22 under 35 U.S.C. §112, second paragraph as being indefinite. (Answer 2-4). The Examiner properly gave notice of the new ground of rejection (Answer 2-4) and the Technology Center Director approved it. (Answer 18-20). As the Answer indicated (Answer 18-19), the Appellants were required to respond to the new ground within two months in either of two ways: 1) reopen prosecution (*see* 37 CFR 41.39(a)(2)(b)(1)); or 2) maintain the appeal by filing a reply brief as set forth in 37 CFR 41.41 (*see* 37 CFR 41.39(a)(2)(b)(2)), "to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection." (Answer 18-19). According to the record before us, neither option appears to have been exercised. Accordingly, the appeal as to claims 17, 19, and 21-22 subject to the new ground of rejection under 35 U.S.C. §112, second paragraph stands dismissed. Upon return of the application to the Examiner, the Examiner should (1) cancel claims 17, 19, and 21-22 subject to the new ground of rejection and (2) notify the Appellants that the appeal as to claims 17, 19, and 21-22 subject to the new ground of rejection under 35 U.S.C. §112, second paragraph, is dismissed and that claims 17, 19, and 21-22 are cancelled. *See* Manual of Patent Examining Procedure (MPEP) § 1207.03, 8th ed., Rev. 7, Jul. 2008. Claims 18, 20, 23, and 34-38 were dependent on claim 17, but not included in the above cited rejection in what is considered a typographical error or an error of omission. We treat

these claim exclusions as a typographical or omission error, and regardless these claims would now depend from a cancelled claim, so these claims are dismissed and the Examiner should cancel them as well. Given that the appeal as to claims 17-23 and 34-38 stands dismissed, the rejections before us for review are reduced to as follows:

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Templeton	US 5,679,938	Oct. 21, 1997
Kamimura	JP 62264364	Nov. 17, 1987
Pasu	JP 11161832 A	Jun. 18, 1999
Nonaka	GB 2303956 A	Mar. 5, 1997

The following rejections are before us for review:

1. Claims 1, 3, 4, 9-16, and 24-33 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Nonaka in views of Kamimura and/or Pasu and Templeton.

THE ISSUES

With regard to claim 1, the issue turns on whether the prior art discloses or suggests the claim limitations which have been argued for by the Appellants. The remaining claims turn on the same or a similar issue.

FINDINGS OF FACT

We adopt the Examiners findings of facts in the Answer related to Nonaka at 7:7-10 and Pasu at 8:17-19. Additional fact may appear in the Analysis section below.

ANALYSIS

The Appellants argue that the rejection of claim 1 is improper because the prior art fails to disclose certain argued elements of claim limitations [1], [3], and [4] as listed in the claim above (Br. 8-13, Reply Br. 2-8). In contrast the Examiner has determined that the rejection of record is proper (Ans. 7-11, 15-18).

We agree with the Examiner. The Appellants first argue at page 8 of the Brief that Nonaka does not disclose elements of claim limitation [1] which requires:

> [1] determining if an identification code for a portable electronic device is listed on a negative list,
> *a presence of said identification code on said negative li*st identifying said portable electronic device *as a disabled device* and
> *an absence of said identification code* from said negative list identifying said portable electronic device *as an enabled device*.
> (Claim 1, emphasis added).

The Appellants argue that Nonaka fails to disclose the *absence* of an ID number as identifying an enabled device. The Examiner acknowledges that Nonaka fails to disclose this, but has determined that this claim limitation would have been obvious since each borrower would have a unique identification, and failure to make a payment would place them "in a negative list" with a disabled device (Ans. 15). The Examiner has also determined that it would have been obvious to make the central computer

aware of accounts that were delinquent (Ans. 10). The Examiner also cites Templeton at Col. 13:35-67 and 12:51-65 as disclosing a "negative file" related to check data of a customer (Ans. 10). Templeton at Col. 13:18-67 does disclose the use of a "negative file," containing bad check data for a customer, to determine if a check will be declined. Here, the use of a single list of all "negative file" records would have been an obvious variation of the cited prior combination, so as to allow the computer to keep track of the negative accounts in the entire group for monitoring the entire group, as opposed to only for just a single customer, to keep track of the entire client group's status. Accordingly, the absence of bad check data for a customer in the "negative file" corresponds to "an absence of said identification code from said negative list," as recited in claim 1.

The Appellants secondly argue that Nonaka fails to disclose elements of claim limitation [3] directed to "recording in said enabled device… information on a loan made to the user… when a payment amount exceeds the remaining amount of the electronic money stored in said enabled device" (Br. 9-10). The Examiner however has not cited to Nonaka to disclose recording in an IC card but, rather cites to Kamimura and/or Pasu to show this (Ans. 16), and the Appellants have failed to show that this element is missing from the prior art of the rejection or not obvious in this regard. Pasu does disclose recording loan data into a prepaid card (Abstract).

The Appellants thirdly argue that Nonaka fails to disclose that the "management center calculates interest on the loan at a predetermined frequency, and uses the calculation result to update said information on the loan" (Br. 9), but the Examiner has stated that this is well known in the art and done by lenders and credit card issuers (Ans. 17). We agree with the

Examiner in this regard as well, as this disputed claim limitation is conventional and well known to be a basic loan interest calculation, and its use in the cited combination is considered an obvious modification to determine the interest payments.

The Appellants have contested that the rejection of record failed to disclose the above cited claim limitations which have been addressed above. The Appellants have not contested the obviousness rationale for combining all the references together. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008)

For these reasons, the rejection of claim 1 and its dependent claims is sustained. Claim 9 contains a similar limitation, and the rejection of that claim and its dependent claims is sustained for these same reasons as well.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1, 3,4, 9-16, and 24-33 under 35 U.S.C. 103(a) as being unpatentable over Nonaka in view of Kamimura and/or Pasu and Templeton.

DECISION

The Examiner's rejection of claims 1, 3, 4, 9-16, and 24-33 is sustained.

AFFIRMED

MP